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10/848,748	05/19/2004	Barbara A. Christensen	RA 5605 (33012/383/101)	4644
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UNISYS CORPORATION			WONG, JOSEPH D	
MS 4773				
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ST. PAUL, MN 55164-0942			2168	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/848,748

Applicant(s)

CHRISTENSEN ET AL.

Examiner

Joseph D. Wong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claim 21 is objected to due to a minor punctuation informality. See MPEP 608.01(k).

Response to Arguments

Applicant's arguments with respect to claims 1-21 have been considered but are moot in view of the new ground(s) of rejection as necessitated by amendment.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 11-20 are rejected for being directed towards nonstatutory subject matter.

Claim 11 is directed to an apparatus. This claimed subject matter lacks a practical application of a judicial exception (abstract idea) since it fails to produce a useful and tangible result.

The claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for “permitting means”, “offering means”, “converting means”, “modifying means” which when construed according to instant specification paragraphs [25-37] recite software or algorithmic capabilities

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instead of a positively recited result. Interpreting claim 11 as invoking 35 USC 112, sixth paragraph did not overcome this ground of rejection. Thus the claim is held nonstatutory.

Claim 11 is directed to an apparatus consisting of software per se because no physical article is observed within the body of the claims. Software per se is not one of the four categories of invention and therefore claims 12-15 are not statutory. Software per se is not a series of steps or acts and thus is not a process. Software per se is not a physical article or object and as such is not a machine or manufacture. Software per se is not a combination of substances and therefore is not a composition of matter. The claim provides for multiple “means of” however the Instant Specification recites capabilities that appear to be implemented using algorithmic or software means in paragraphs [25-37]. Since a physical article is neither positively recited within the claim nor positively recited within every disclosed embodiment, doubt is raised as to what whether every article within the claim is abstract or an abstract manipulation thereof.

Claim 16 appears to be a data processing system nested with user steps making it unclear which elements must be present to meet the claim because the claim recites abstract elements and steps. MPEP 2173.05(p)(1) states:

Such claims *may< also be rejected under 35 U.S.C. 101 based on the theory that the claim is directed to neither a “process” nor a “machine,” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth the statutory classes of invention in the alternative only. Id. at 1551

Claim 16 is directed to data processing steps of software per se because no physical article is observed within the body of the claims. Software per se is not one of the four categories of invention and therefore claims 17-20 are not statutory. Software per se is not a series of steps or acts and thus is not a process. Software per se is not a physical article or object

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and as such is not a machine or manufacture. Software per se is not a combination of substances and therefore is not a composition of matter. Since a physical article is neither positively recited within the claim nor positively recited within every disclosed embodiment, doubt is raised as to what whether every article within the claim is abstract or an abstract manipulation thereof.

Applicants can look to MPEP 2106.01-2106.02, 707.06 (August 2006), Interim Guidelines, Instant Specification, and contemporary case law with a matching fact pattern for further suggestions that may be helpful in overcoming these rejections.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Rangnekar, US Pre-Grant Pub. No. 2005/0192851 A1, filed 26 Feb. 2004, Pub. Date 1 Sep. 2005.

Regarding claim 1, Rangnekar teaches an apparatus comprising:

a. a terminal which generates a user request in a standardized object-based command language for access to a data base; (interpreted to include “ATM., End User”, Fig. 5B, Fig. 2, [0123]; where an automatic teller machine is used as a terminal)

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b. a legacy data base management system responsively coupled to said terminal which honors said user request by execution of a non-standardized command language to produce a result from a dataset within said data base; (interpreted to include “centralized reservation system”, [007], [142])

c. a conversion facility for conversion of said standardized object-based command language to said nonstandardized command language (interpreted to include “HTML”, [118-119]; Figs. 18-19); and

d. a facility responsively coupled to said legacy data base management system which prepares said result for transfer to said terminal and which modifies said dataset if and only if specified in said service request. (interpreted to include “XML document is updated at a financial services system server only if there is a change in the city data”, [118-119], [125-126], [138])

Regarding claim 2, Rangnekar teaches the apparatus wherein said terminal is coupled to said legacy data base management system via a publicly accessible digital data communication network. (interpreted to include “internet based websites such as Expedia...Priceline”, [11], [7])

Regarding claim 3, Rangnekar teaches the apparatus wherein said user request specifies said dataset. ([8-9])

Regarding claim 4, Rangnekar teaches the apparatus wherein said publicly accessible digital data communication network further comprises the Internet. ([11])

Regarding claim 5, Rangnekar teaches the apparatus of wherein said standardized object-based command language further comprises a commonly available command language. ([107])

Regarding claim 6, Rangnekar teaches a method of utilizing a terminal to access a legacy data base management system having a data base employing a non-standardized command language comprising:

- a. transmitting a service request in a standardized object based command language from said terminal requesting access to said data base of said legacy data base management system (interpreted to include “prints your itinerary”, Fig. 24; [40], [86]);
- b. receiving-said service request by said legacy data base management system; (interpreted to include “GDS”, “Apollo Galileo”, “Amadeus”, [92])
- c. converting said service request in said standardized object-based command language into said non-standardized command language; (interpreted to include “converted to a query that is understandable by CRS 30”, [142], where CRS is a legacy system such as shown above)
- d. honoring said service request by executing said nonstandardized command language to access a dataset from said data base by said legacy digital data base management system; and e. modifying said dataset if indicated by said service request. (interpreted to include “charge the transaction....routed to the built-in printer at ATM12 for printing...”, [150])

Regarding claim 7, Rangnekar teaches a method wherein said dataset is specified by said service request. (Fig. 25, see top reverse highlight)

Regarding claim 8, Rangnekar teaches a method wherein said transmitting step occurs over a publicly accessible digital data communication network. (interpreted to include “internet”, box 4 from top left corner, Fig. 2)

Regarding claim 9, Rangnekar teaches a method according wherein said publicly accessible digital data communication network further comprises the Internet. (interpreted to include “Internet Explorer”, [118])

Regarding claim 10, Rangnekar teaches a method according to claim 9 wherein said standardized object-based command language further comprises-a commonly used command language.

Regarding claim 11, Rangnekar teaches an apparatus for providing access to such legacy data base management systems using a standardized object-based programming language to efficiently provide a resultant report comprising:

- a. permitting means for permitting a user to transfer a service request defined by a standardized object-based command language;
- b. offering means responsively coupled to said permitting means via said publicly accessible digital data communication network for offering legacy data base management services involving access to at least one dataset having a nonstandard scripted command language;
- c. converting means responsively coupled to said offering means for converting said service request from said standardized object-base command language to said nonstandardized scripted command language;
- d. modifying means responsively coupled to said offering means for modifying said dataset if so indicated by said service request; and
- e. providing means for providing said resultant report to said user.

Regarding claim 12, Rangnekar teaches an apparatus wherein said dataset is specified by said service request. (Fig. 22)

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Regarding claim 13, Rangnekar teaches an apparatus further comprising means located within said permitting means for generating a second service request. (Figs. 22-23)

Regarding claim 14, Rangnekar teaches an apparatus wherein said offering means further comprises a commercially available data base management system.

Regarding claim 15, Rangnekar does not explicitly teach an apparatus wherein said permitting means further comprises an industry standard personal computer. ([170])

Regarding claim 16, Rangnekar teaches a data processing system having a terminal which generates a service request in a standardized object-based command language responsively coupled to a legacy data base management system which accesses a dataset to honor said service request by executing a non-standardized command language,

a. a conversion facility responsively coupled to said legacy data base management system which converts said service request from said standardized object-based command language

(interpreted to include “Perl using COM”, [207]) to said non-standardized command language;

and (interpreted to include “CRS”, [207])

b. a facility which modifies said dataset only if indicated by said service request. (interpreted to include “Cancelled means that this transaction was cancelled upon the customer’s request”,

[220])

Regarding claim 17, Rangnekar teaches the data base management system wherein said dataset is specified by said service request.

Regarding claim 18, Rangnekar teaches the data base management system wherein said terminal is responsively coupled to said legacy data base management system via a publicly

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accessible digital data communication network. (interpreted to include “internet”, see left most box “End User->Internet” in the two o’clock position away from the left most box, Fig. 2)

Regarding claim 19, Rangnekar teaches the data base management system wherein said publicly accessible digital data communication network further comprises the Internet. (see left most box “End User->Internet” in the two o’clock position away from the left most box, Fig. 2)

Regarding claim 20, Rangnekar teaches the data base management system wherein said standardized object based command language further comprises a commonly utilized command language. (interpreted to include “Perl using COM architecture”, [207])

Regarding claim 21, Rangnekar teaches an apparatus for accessing a database comprising:

a. a terminal which generates a user request in a standardized object-based command language which specifies access to a dataset within a data base; (intepreted to include “.pl”, see top Window bar of Figs. 16-17, the “.pl”. extension suffix whose dictionary definition is read in light of paragraph [207, 210] reciting “Perl” and a definition observed in Wikipedia.org)

b. a legacy data base management system responsively coupled to said terminal via a publicly accessible digital data communication network (interpreted to include “End User->internet”, Fig. 12) which honors said user request by execution of a non-standardized command language to produce a result from said dataset; (interpreted to include “request via Phone”, “Agents 2-5...travel desk”, Fig. 5B)

c. a conversion facility for conversion of said standardized object-based command language (interpreted to include “.pl” in Fig. 29, where “.pl” extension is defined as invoking the language of PERL whose dictionary definition is read in light of Wikipedia.org or beginner

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PERL tutorial at PERL.com) to said nonstandardized command language (interpreted to include “CRS”, Fig. 35, the centralized reservation system includes legacy systems which are interpreted as meeting the negative limitation); and

d. a facility responsively coupled to said legacy data base management system which prepares said result for transfer to said terminal and which modifies said dataset if and only if specified in said service request ([142], [145], [155], [161])

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 1, 6, 11, 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6, 11, 16 of copending Application No. 10/848,758. Limiting a command-language to being object based and necessarily linking a

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modification to a request are obvious in view of Winter, US Pre-Grant Pub. No. 2004/0226027 A1, Filed 6 May 2003, Pub Date 11 Nov 2004.

This is a provisional obviousness-type double patenting rejection.

Claim 1, 6, 11, 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6, 11, 16 of copending Application No. 10/848,473. Limiting a command-language to being object based and necessarily linking a modification to a request are obvious in view of Winter, US Pre-Grant Pub. No. 2004/0226027 A1, Filed 6 May 2003, Pub Date 11 Nov 2004.

This is a provisional obviousness-type double patenting rejection.

Claim 1, 11 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6 and 11 copending Application No. 10/848,899. Limiting a command-language to being object based and necessarily linking a modification to a request are obvious in view of Winter, US Pre-Grant Pub. No. 2004/0226027 A1, Filed 6 May 2003, Pub Date 11 Nov 2004.

This is a provisional obviousness-type double patenting rejection.

Claim 1, 11 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6 and 11 copending Application No. 10/848,901. Limiting a command-language to being object based and necessarily linking a modification to a request are obvious in view of Winter, US Pre-Grant Pub. No. 2004/0226027 A1, Filed 6 May 2003, Pub Date 11 Nov 2004.

This is a provisional obviousness-type double patenting rejection.

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Claim 1, 11 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6, 11, 16 of copending Application No. 10/848,469. Limiting a command-language to being object based and necessarily linking a modification to a request are obvious in view of Winter, US Pre-Grant Pub. No. 2004/0226027 A1, Filed 6 May 2003, Pub Date 11 Nov 2004.

This is a provisional obviousness-type double patenting rejection.

Claims 1, 6, 11, 16 and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6, and 16 of US Patent No. 6,832,237 in view of Winter, US Pre-Grant Pub. No. 2004/0226027 A1, Filed 6 May 2003, Pub. Date 11 Nov 2004. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the recent application are substantially similar to claims in US Patent No. 6,832,237.

Claims 1, 6, 11, 16 and 21 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6, and 16 of US Patent No. 6,721,722 in view of Winter, US Pre-Grant Pub. No. 2004/0226027 A1, Filed 6 May 2003, Pub. Date 11 Nov 2004. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the recent application are substantially similar to claims in US Patent No. 6,721,722.

Claims 1 and 2 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6 and 10 of US Patent No. 7,013,341 in view of Winter, US Pre-Grant Pub. No. 2004/0226027 A1, Filed 6 May 2003, Pub. Date 11 Nov 2004. Although the conflicting claims are not identical, they are not patentably distinct from each other

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because the claims in the recent application are substantially similar to claims in US Patent No. 6,721,722.

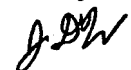
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Wong whose telephone number is 571-270-1015. The examiner can normally be reached on Mon.-Thur. 8:30AM - 6:00PM and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571) 272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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23 July 2007

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